

## REMARKS

Claims 83 - 103 are pending. Claims 1 – 82 were previously canceled.

The new rejections based on Bradshaw (US Patent No. 5,835,722) and other references are addressed through the traverse, amendment and arguments provided below. Reconsideration is respectfully requested.

### Rejection of claims 96 – 103 under § 101

Claims 96 – 103 have been amended to use appropriate language for computer usable media as set out in Ex Parte Li (BPAI No. 2008-1213) decision. The Li decision notes that:

*It has been the practice for a number of years that a "Beauregard Claim" of this nature be considered statutory at the USPTO as a product claim. (MPEP 2105.01, I). Though not finally adjudicated, this practice is not inconsistent with *In re Nuijten*. (*Ibid.*). Further, the instant claim presents a number of software components, such as the claimed logic processing module, configuration file processing module, data organization module, and data display organization module, that are embodied upon a computer readable medium. This combination has been found statutory under the teachings of *In re Lowry*, 32 F.3d 1579 (Fed. Cir., 1994) (emphasis added)*

The claims here now similarly recite the inclusion of computer usable media, and as the Examiner can see, similarly present a number of software components, thus qualifying as a product claim. Accordingly per the Li decision Applicant submits that the claims should pass muster under § 101.

### Response to rejection of claims 83, 84, 87, 92, 94, 96, 100 and 101 in light Bradshaw (US Patent No. 5,835,722) - ¶ 9

#### Traverse based on lack of compact prosecution

As an initial matter, Applicant submits that the new rejection in light of Bradshaw violates the rules against compact prosecution for several reasons.

First, this case has now been pending for almost 5 ½ years, and the newest rejection merely rehashes points that were already discussed and resolved years ago in related applications. For the first approximately four years the Examiner insisted repeatedly that the Cohen reference rendered the claims unpatentable. Only after filing the Appeal Brief

pointing out the errors in this rationale does the Examiner now withdraw such rejections, but now intercedes with new rejections based on Bradshaw.

But Bradshaw is hardly a new reference. It was cited repeatedly in the parent case to the present application, and in all the related applications. For the Examiner now to suggest that such reference now bears on the patentability of the claims violates the rule that the *first* Office Action (issued almost 3 years ago) should have cited such reference if it was truly relevant.

For these reasons Applicant objects to the PTO practice of repeatedly failing to reach finality for the prosecution in the present application. The present discussion of Bradshaw, to the extent it is even relevant, should have occurred three years ago. Indeed the Applicant's rights are now impaired by several years of improper tactics which have not advanced prosecution to a conclusion.

#### Bradshaw et al. does not anticipate the claims

More to the point of course, Bradshaw et al. does not anticipate the claims. As a preliminary matter and before examining the claim limitations in more detail, Applicant believes that a review of the Bradshaw reference is in order, since it forms the basis for the bulk of the rejections made by the Examiner, and this discussion is helpful to an understanding of the more detailed arguments presented further below.

The Bradshaw et. al. reference bears some superficial semblances to some aspects of the present invention, in that it is directed generally to the problem of blocking the transmission of unwanted content, such as vulgar and/or pornographic material. See, e.g. Bradshaw Abstract. The Bradshaw disclosure is particularly concerned with so-called internet filters, which systems were prevalent in library computer systems, especially in public schools. From a high level perspective, however, the goal of this type of system, is slightly different from that of the present invention, in that the Bradshaw approach seeks to solve the problem of absolutely preventing a person from gaining *receipt* of inappropriate material from a third party (*i.e.*, such as the Internet) towards the user, while the present invention is more oriented towards the opposite situation: *i.e.*, trying to give the user tools to allow them to avoid disseminating inappropriate material to a third party.

While both problems share some similarities, there are also some important

differences which express themselves in how the problem is optimally solved in both environments. In Bradshaw, for example, the solution is directed mostly to ways of detecting and preventing inappropriate *requests for access* to restricted files, restricted websites, etc. using very rigid and inflexible filtering rules so that users can be blocked from the same, and so that the user's access to the system can be curtailed (or prohibited). The present invention is not so concerned with access so much as it is with intelligent *distribution*, and so the Bradshaw filtering techniques could be used in a complementary fashion with embodiments practicing the present claims.

The other general limitations of Bradshaw include the fact that is basically only a pure filtering mechanism, so there is little discussion given to the kind of approach discussed in the present claims, which pertain more generally to intelligent email distribution schemes. Moreover, while the present invention uses some degree of filtering for examining document content, and can be used in document filtering environments, it is extremely flexible and unlike the system shown in Bradshaw which is relatively rigid, and which appears to apply to every kind of communication passed into the system without regard to the type of document, the sender, the recipient, etc.

In Bradshaw restricting/blocking access is so important that, if the system detects one of the prohibited words, it locks up the user's computer, preventing him/her from further activity. See e.g., Bradshaw at column 9, ll. 1 – 9. It can be seen quite plainly that this is not practical in many real world working environment where it is entirely possible that entry of such prohibited words might be inadvertent, and yet an employee might waste valuable time trying to get a supervisor to reset the employee's machine. While some milder measures are contemplated (see e.g., column 9, ll. 31 – 35) it is apparent overall that the Bradshaw system is not intended or geared to assist a user in any respect to understand an inappropriate error, and/or to permit fixing the same. However, various embodiments of the present claims accomplish just that.

Another limitation of Bradshaw is that it only teaches a system that is non-user adjustable. In other words, the filter is there, it is essentially fixed/static, and the assumption is that the user should not remove or adjust it in any fashion. This deficiency also is important vis-à-vis many of the claims of the present invention as discussed in more detail herein, which specifically concern allowing a user to control the document content directly.

Another important limitation in Bradshaw that is material to many of the pending claims concerns the fact that the filtering or detecting of inappropriate language is not done by considering the particular “intended recipient” of an email message. In other words, the filtering is rigid, fixed and indiscriminate, and does not allow a system to specify, for example, that certain entities might be suitable recipients of particular subject matter. There is no ability or consideration given to distinguish between potential recipients of files, unlike as set out in various of the present claims. Again, this is a simple consequence of the fact that Bradshaw is looking at an opposite problem - i.e., how to restrict access - and not how to prevent dissemination – so it cannot teach this aspect of the invention as expressed and amplified in other of the pending claims.

Finally, other claims emphasize for example that the content of an email can be checked by reference to threshold values (i.e., by specifying a language sensitivity for a particular email). In other words the present inventions describe embodiments where different filters can be used with different groups, and different filters/thresholds can be used with different documents. These features are plainly not described or suggested in Bradshaw, and accordingly, these claims, too, are believed to be allowable.

The rejections for each of the individual claims are now addressed in detail below.

### Claim 83

For claim 83, the main point raised by the Examiner is that a “supervisor” in Bradshaw et al. could write an offensive message, and then with an administrative password could theoretically bypass the X-stop controls to disseminate the email anyway. However this is not contemplated by the reference, as the Examiner has misread the pertinent passage of Bradshaw et al.:

omitted herein for convenience. The “user” may be a child, student, or company employee. The “supervisor” may be a parent, teacher, or company supervisor, i.e., anyone who has authority to control the user of the computer system in which X-Stop is installed. The invention is a computer terminal

There is no indication that the “supervisor” is allowed to be a “user” so that he/she could circumvent the system as the Examiner suggests. In fact, the two definitions are set out distinctly and separately, and Bradshaw et al. specifically does *not* include “supervisor”

within the definition of persons who can be a "user." This is a rather glaring omission.

But the omission is clearly intentional. The Examiner's proposed modification of Bradshaw et. al. in fact renders it inoperable for its intended purpose. Bradshaw imposes very rigid rules on a document drafter (as evidenced by the keyboard capturing mechanism and lockout scheme) and they cannot be circumvented or altered by a user, whether or not they are a supervisor. To do so, in fact, would defeat the whole purpose of Bradshaw's filtering mechanism.

In contrast to Bradshaw, the claims of the present invention focus on user ease of use features, and permit a document author to custom tailor *how* documents are checked, and what is done. This latter point illustrates another deficiency in the Examiner's argument. The supervisor in Bradshaw, even if allowed access to the email programs as the Examiner suggests, is not able to select "...a language filter for checking words in the email message..." Indeed, the only filter shown in Bradshaw et al. is a single default filter (called Library 3) which is used system wide – thus no filter is thus "selected" because it can never be varied/augmented, etc. That is, the users are not allowed to specify *which* filters should be used, including, for example, certain additional customized filters which are described in the present application as desirable for authors.<sup>1</sup> Applicant believes that this limitation of permitting the author to select at least one filter was already well expressed in the preamble, but has amended claim 83 to make it more explicit.

Accordingly Applicant submits that Bradshaw fails to disclose all limitations of claim 83 and therefore cannot anticipate the same. Claims 84, 87, 92, 94, 96 and 100/101 should be allowable for at least the same reasons.

#### Response for claims 85 – 85 - ¶ 11.

These claims should be allowable for at least the same reasons as claim 83, from which they depend. Moreover, claim 86 recites that a plurality of filters could be triggered, and the method identifies which one is implicated. There is no such feature in Cohen, which uses a single dictionary.

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<sup>1</sup> The Examiner's citation to col. 7, ll. 18 – 26 does not show "selecting" a language filter for checking words. This section discusses the Supervisor's *review* of email which has been characterized by a default filter as containing foul language. Note that these emails, however, can only come from outside the X-stop program since all emails within the system cannot be sent at all (the computer is locked down) if they contain offensive

Response for claims 88, 89 and 97 - ¶ 12

These claims should be allowable for at least the same reasons as claim 83, from which they depend. Moreover, claim 89 recites that the *language filter* has foreign words; the Stamps reference is merely a spell-checker. There is no indication that the dictionaries are configured to contain words that are specifically identified as offensive/inappropriate. Moreover, there is no indication that the dictionary contains both English and non-English words; it merely says that there is a dictionary. Thus, it is not a language "filter" as set out in the claims, and combining it with Bradshaw would not therefore result in the invention of claim 89. Claim 97 should be allowable for at least the same reason as claim 86 above, because there are multiple dictionaries involved.

Response to rejection of claims 90, 91, 93, 98 and 99 in light of Bradshaw (5,835,722) and Russell – Falla (6,675,162) - ¶ 13

As Bradshaw is again cited here for a proposition that it cannot support, Applicant submits that the rejection cannot stand. It simply does not teach or suggest the limitation of underlying claim 83 from which claims 90, 91 depend.

The Examiner misconstrues the arguments about Russell-Falla; the question is not if it shows "thresholds" but for what reason, and who gets to set them. The reference shows setting a threshold on a browser, not on an email or other document. Moreover these are not thresholds being used by an author of an email message; they are thresholds being used by a web surfer looking at web pages. For this reason the reference is simply inapposite.

Concerning independent claim 93; this claim should be allowable for at least the same reasons as claim 83 based on the distinctions over Bradshaw. Moreover Applicant incorporates by reference the arguments already set forth against the Russel-Falla reference. It does not teach or suggest the limitation of claim 93:

...setting a sensitivity threshold provided by the author to also be used in connection with checking appropriateness of content included in the email message

The Examiner cites col. 5, ll. 33+ of Russel – Falla. Again, see above; the reference says nothing about allowing *authors* to control the content of their messages.

Accordingly this claim is believed to be distinguishable over the cited combination, which does not permit the author of the document to adjust a sensitivity threshold.<sup>2</sup>

Claims 98 – 99 should be allowable for essentially the same reasons as claim 93.

Response to rejection of claims 95 and 102 - 103 in light of Bradshaw (5,835,722) taken with Rayson (5,761,689) - ¶ 14

Independent claim 95 should be allowable for the same reasons as claim 83 previously discussed. Moreover as noted earlier as well, Applicant disagrees with the argument that one skilled in the art would reasonably combine Rayson with Bradshaw. The latter, in fact, insists that input by the author is scanned immediately after it is entered, which is 180 degrees opposite of the technique taught in Rayson. Accordingly the proposed modification would alter Bradshaw in a manner that is inconsistent and incompatible with the latter's teachings.

Independent claim 102 should be allowable for the same reasons as claims 83, 94 – 95 and 100 previously discussed, and for the reasons set out in the prior response.

Dependent claim 103 should be allowable for at least the same reasons.

Independent claim 100 should be allowable for the same reasons as claims 83 and 94 – 95 previously discussed. Dependent claim 101 should be allowable for at least the same reasons.

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filter, as the latter is universally applied to incoming email.

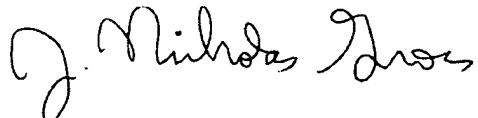
<sup>2</sup> Again no admission or inference should be drawn from the present record as to the nature or scope of other claims issued or pending to the Applicant to such subject matter which do not specifically recite the language at issue here for this claim.

## CONCLUSION

The references and rejections have been addressed in detail, and Applicant respectfully submits that the Application be sent on for allowance.

A petition and fee for an extension of time is also enclosed. Should the Examiner believe it that it would be helpful to discuss any of the above points in person, Applicant is open to a telephone conference (510 - 540 - 6300) at any convenient time.

Respectfully submitted,



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